

ESTTA Tracking number: **ESTTA608619**

Filing date: **06/06/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91207216
Party	Defendant Pure Glass Distribution, Inc.
Correspondence Address	ERIC S HYMAN BLAKELY SOKOLOFF TAYLOR ZAFMAN LLP 12400 WILSHIRE BOULEVARD, SEVENTH FLOOR LOS ANGELES, CA 90025 1019 UNITED STATES pete_bromaghim@bstz.com, garbo_tat@bstz.com, tm_filings@bstz.com, eric.hyman@bstz.com, alexis_karriker@bstz.com
Submission	Reply in Support of Motion
Filer's Name	Pete Bromaghim
Filer's e-mail	pete_bromaghim@bstz.com, garbo_tat@bstz.com, tm_filings@bstz.com, eric_hyman@bstz.com, alexis_karriker@bstz.com
Signature	/PeteBromaghim/
Date	06/06/2014
Attachments	8901.M002 Applicant's Reply in Support of Motion for Involuntary Dis- missal.PDF(1076587 bytes)

NATHAN AWEIDA,)	
)	
)	Opposition No.: 91207216
Opposer,)	
)	Serial No.: 85/374,436
v.)	Published: May 29, 2012
)	
PURE GLASS DISTRIBUTION, INC.,)	Mark: SWISS PERC and design
)	
Applicant.)	
)	

Applicant, Pure Glass Distribution, Inc., by and through its undersigned attorneys of record, hereby replies to Opposer Nathan Aweida's Response to Applicant's Motion for Involuntary Dismissal ("Response"), filed May 22, 2014, as follows.¹

As an initial matter, Applicant must note that Opposer did not file its response within the prescribed period to do so. Under 37 CFR § 2.119(c), TMBP §502.02(b) and 534.02, a brief in response to a Motion for Involuntary Dismissal must be filed within 15 days from the date of service of the motion. It was not in this case.

¹ Applicant is aware that the Board discourages reply briefs, but under the unique circumstances of the short original Motion and the content of Opposer's Response, Applicant believes it necessary to submit some additional information that is not of record and which supports Applicant's Motion to Dismiss.

without the additional five days normally allotted for mail service. See Declaration of Peter Bromaghim (“Decl.”) (Exhibit 1), at ¶3. Opposer’s counsel prepared a helpful summary of the discovery conference that detailed the same. *Id.*; Exhibit 2. Applicant’s Motion was filed on May 2, 2014 and served via email on Opposer’s counsel the same day. *Id.* at ¶4; Docket No. 13. Opposer’s Response was filed with the Board on May 22, 2014, and served on Applicant’s counsel on the same day. *Id.* at ¶5; Docket No. 15. Opposer’s counsel did not seek an extension of time to respond, nor was there any communication between the parties during this time. *Id.* at ¶6. Accordingly, as the Response was filed 20 days after the Motion, it is untimely.

The Board precedent that most closely follows this scenario is *Boyd’s Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017 (TTAB 2003) (Cancellation No. 92032146). There, the Board refused to consider the registrant’s response to the petitioner’s motion to suspend based on a civil action filing, where the registrant’s response was (a) untimely, and (b) there was a dispositive motion before the Board following petitioner’s failure to provide any acceptable testimony during its testimony period. *See id.* at 2018-19. The situation here is directly analogous, and Opposer’s Response should not be considered by the Board.

II. Additional Facts Relevant to Excusable Neglect

Should the Board address the merits of Opposer’s Response, Applicant wants to make clear that it has no desire to weigh or otherwise assess the facts presented by Opposer in its Response and its Confidential Statement in support of the same. Whether the facts presented meet the standard of “good and sufficient cause” (equivalent to “excusable neglect” under FRCP 6(b)) for failing to take testimony or present any evidence during Opposer’s testimony period is a determination for the Board, which is no doubt aware of its previous opinions in this regard. *See*

Boyd's Collection Ltd., supra; Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp., 178 USPQ 429, 430 (TTAB 1973) (motion to suspend filed after the conclusion of testimony and briefing periods denied); *see also* TBMP 534.02.

Applicant does want to ensure that the Board is aware of all facts relevant to its determination of “excusable neglect,” however. Applicant believes the following facts, which cannot be reasonably disputed by Opposer, and which were not specifically mentioned in Opposer’s Response, are of particular relevance.

- The last communication of any kind between counsel for the parties prior to the Motion filing were emails exchanged on December 2, 2013, wherein the parties agreed to an additional extension of the discovery period. (Decl. at ¶8.) The subject Motion was served and filed on May 2, 2013. This constitutes a full six-month period in which Opposer could have moved to extend or re-open time for discovery or testimony as necessary.
- Opposer’s counsel is a partner at a ten-attorney firm with multiple attorneys handling intellectual property matters. (Decl. at ¶7.)
- Applicant had no reason to believe that Opposer’s recent inaction on this matter was due to the intended filing of a civil action, or anything other than a lack of interest in pursuing the matter. (Decl. at ¶9.)
- As of the date of filing of this reply, the complaint submitted as Exhibit 1 to Opposer’s Response has not been served on Applicant. (Decl. at ¶10.) As a result, Applicant has not been joined as a party to the referenced case.

III. Applicant Would Be Prejudiced by Suspension Based on Opposer's Civil Suit

The Trademark Board Manual of Procedure makes clear that, while the Board has the discretion to suspend a case at any time based on a civil action that may bear on the Board case, the Board is also particularly concerned about civil suits filed in response to potentially dispositive motions. As TBMP 510.02(a) states:

If there is pending, at the time when the question of suspension of proceedings before the Board is raised, a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered. [Note omitted]. The purpose of this rule is to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion.

One can easily see the inequity of preparing, for example, a summary judgment motion before the Board, only to have the opposing party dodge the determination on the merits by filing a civil suit and seeking suspension. It would be even more inequitable to suspend in the case at hand, where the suit and suspension request have been filed after Opposer's own trial testimony period has closed. The Board's precedents in this regard support the same (see *supra*). Furthermore, based on the fact that the civil suit has not been served in two weeks' time, Applicant can only assume that Opposer has no interest in actually proceeding with the suit, and that it is instead being used as a tactic to avoid a determination on the pending Motion. The fact that the suit has been filed in Washington, where Opposer and its counsel are located, but where Applicant has no place of business, supports the same inference. The Board should continue to discourage such last-second attempts at "escaping" judgment.

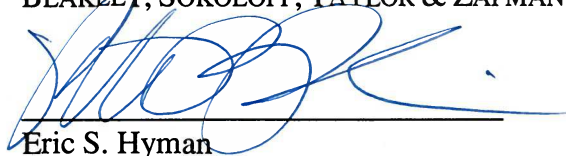
At the same time, the Board should encourage the filing of Motions for Involuntary Dismissal where the party in the position of Plaintiff has filed no testimony or evidence, and thus cannot prevail, in order “to save the defendant the expense and delay of continuing with the trial.” TBMP § 534.02. Applicant has every reason to believe that if it did not file the subject Motion, the case would have proceeded to judgment from the Board in due course, without any further communication or motion from Opposer. In effect, if the Board grants Opposer’s request to suspend following the close of its own testimony period, Applicant would be prejudiced simply by virtue of proactively monitoring the case, and trying to avoid further expense and delay.

IV. Conclusion

For all of the foregoing reasons, Applicant respectfully requests that the Board grant Applicant’s Motion for Involuntary Dismissal in its entirety.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP



Eric S. Hyman
Peter Bromaghim
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025
(310) 207-3800

Dated: June 6, 2014

Attorneys for Applicant Pure Glass Distribution, Inc.

CERTIFICATE OF SERVICE

I, Garbo Tat, hereby declare that I am employed by the law firm of Blakely, Sokoloff, Taylor & Zafman, 12400 Wilshire Boulevard, Seventh Floor, Los Angeles, California 90025-1040; that I am over 18 years of age and not a party to the within action; and that I served the following document, APPLICANT'S REPLY IN SUPPORT OF MOTION FOR INVOLUNTARY DISMISSAL, on the date indicated below, by electronic mail as agreed upon by the parties, to the addresses below:

Jonathan Feil
jfeil@sksp.com

CC: Sandra Snow

Date: _____

June 6, 2014



Name: Garbo Tat

EXHIBIT 1

NATHAN AWEIDA,)	
)	
Opposer,)	Opposition No.: 91207216
)	
v.)	Serial No.: 85/374,436
)	Published: May 29, 2012
)	
PURE GLASS DISTRIBUTION, INC.,)	Mark: SWISS PERC and design
)	
Applicant.)	
)	

I, PETER BROMAGHIM, declare as follows:

2. In representing Applicant Pure Glass Distribution, Inc., I have communicated with counsel for Opposer, Jonathan I. Feil, regarding this Opposition since its inception.

3. Pursuant to the parties' agreement at the initial discovery conference, all documents in this matter were to be served via email, and all response deadlines calendared accordingly, without the additional five days normally allotted for mail service. Attached as Exhibit 2 to Applicant's Reply is a true and correct copy of email correspondence between Mr. Feil and me, confirming the same.

4. Applicant's Motion for Involuntary Dismissal was filed on May 2, 2014 and served via email on Opposer's counsel the same day, which is also reflected in the prosecution history of the case (Docket No. 13).

5. Opposer's Response was filed with the Board on May 22, 2014, and served on Applicant's counsel on the same day, which is also reflected in the prosecution history of the case (Docket No. 15).

6. Opposer's counsel did not seek an extension of time to respond to the Motion, nor was there any communication between the parties during this time.

7. I am aware, based on my review of <http://sksp.com>, that Opposer's counsel is a partner at a ten-attorney firm with multiple attorneys handling intellectual property matters.

8. The last communication of any kind between counsel for the parties prior to the filing of the Motion for Involuntary Dismissal filing were emails exchanged on December 2, 2013, wherein the parties agreed to an additional extension of the discovery period.

9. I had no reason to believe, nor did any representatives for Applicant, that Opposer's recent inaction on this matter was due to the intended filing of a civil action, or anything other than a lack of interest in pursuing the matter.

10. As of the date of filing of this reply, based on my correspondence with representatives for Applicant, I am not aware of the complaint submitted as Exhibit 1 to Opposer's Response having been served on Applicant.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed this 6th day of June, 2014.


Peter Bromaghim

EXHIBIT 2

Pete Bromaghim

From: Pete Bromaghim
Sent: Friday, December 07, 2012 3:39 PM
To: 'Jonathan Feil'
Cc: Eric S. Hyman
Subject: RE: Discovery Conference - Aweida v Pure Glass Distribution (TTAB 91207216)

Thanks Jonathan.

With regard to the Protective Order, I've compared your version with the TTAB standard Order, and I am not seeing any substantive changes, just some minor rewording at the outset. I've electronically checked the same. Can you please advise if there are any other additional changes of which we should be aware (on the off-chance our reviews were faulty)? If not, I don't see any other issues with your version.

Thanks,
Pete

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From: Jonathan Feil [mailto:JFeil@sksp.com]
Sent: Friday, December 07, 2012 2:49 PM
To: Pete Bromaghim
Cc: Eric S. Hyman
Subject: RE: Discovery Conference - Aweida v Pure Glass Distribution (TTAB 91207216)

Pete:

Here are the minutes of our discovery conference, held by telephone conference on December 6, 2012:

- (1) Nature and basis of claims and defenses: We each addressed questions we had respectively at this time regarding the allegations in the other side's pleadings.
- (2) Possibility of settlement. As a starting point for discussions, I requested a response to plaintiff/opposer's initial infringement notice (copy attached), per Dax Alvarez's email dated November 14, 2011.
- (3) Modification of the pleadings. Not anticipated.
- (4) Plans for disclosures and discovery. Initial disclosures will be exchanged per the Board's scheduling order. We did not see the need to file the disclosures with the Board. We will discuss discovery further after reviewing the other side's initial disclosures.
- (5) Protective order. Attached is my customization of the TTAB standard provisions for protecting confidentiality, which is satisfactory to opposer/plaintiff. If acceptable to you and your client, please sign and I will file it with the Board. If not, please let me know what questions or objections you have.

- (6) Mediation, arbitration or Board's Accelerated Case Resolution option. Neither party requests mediation or arbitration at this time, without prejudice to requesting use of either or both procedures at a future point in the case. Similarly, neither party requested use of the ACR option prior to or at the discovery conference. However, the parties may agree to pursue ACR after some disclosures and discovery.
- (7) Stipulations of fact or as to manner in which evidence may be presented at trial. Neither party has proposed or offered stipulations of fact at this time, without prejudice to doing so at a later time. I suggested during our telephone conference that the parties stipulate to the authentication and identification of exhibits containing their respective trademark applications. Please review the attached files and let me know if we can stipulate that they satisfy the requirements of authentication and identification under FRE 901(a).
- (8) Additional topics. Counsel for both parties have agreed to service by email, without the need for hard copy by U.S. mail. Email service on counsel for plaintiff/opposer will be addressed to Jonathan Feil (jfeil@sksp.com), cc: Annabel Renner (arenner@sksp.com). Email service on counsel for defendant/applicant will be addressed to Pete Bromaghim (peter_bromaghim@BSTZ.com) and Eric Hyman (eric_hyman@bstz.com), cc: Kyle Samia (kyle_samia@bstz.com) and Alexis Karriker (alexis_karriker@bstz.com).

Please confirm that these are accurate or let me know what you believe needs to be corrected or added.

Regards,

Jonathan

P.S. On the lighter side, this is the clip about the use of official minutes - <http://youtu.be/85fx0LrSMsE> (best and most apt part begins at 2:16).

Jonathan I. Feil

jfeil@sksp.com

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LinkedIn Network Profile - <http://www.linkedin.com/in/jfeil>

Member, International Business Law Consortium - www.iblc.com

From: Pete Bromaghim [mailto:Peter_Bromaghim@BSTZ.com]

Sent: Thursday, December 06, 2012 11:56 AM

To: Jonathan Feil

Cc: Eric S. Hyman

Subject: RE: Discovery Conference - Aweida v Pure Glass Distribution (TTAB 91207216)

Jonathan,

As discussed, we will agree to service by email. We request that you include both me and Eric Hyman (eric_hyman@bstz.com), along with our respective assistants Kyle Samia (kyle_samia@bstz.com) and Alexis Karriker (alexis_karriker@bstz.com) on service emails. I realize that's a lot of email addresses, but it will be the best for our system here. For informal correspondence, please direct that to me and CC: Eric.

We'll include your assistant (arenner@sksp.com) as requested on email service.

Thanks,
Pete

Pete Bromaghim
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From: Jonathan Feil [<mailto:JFeil@sksp.com>]
Sent: Thursday, December 06, 2012 10:50 AM
To: Pete Bromaghim
Subject: Discovery Conference - Aweida v Pure Glass Distribution (TTAB 91207216)

Pete:

In preparation for our discovery conference (about a half hour from now), I would like to propose that we be guided by the list of topics at 72 Fed. Reg. 42242, 42252 (2007), which the PTO provided as part of its explanation of the August 1, 2007 TTAB rules changes:

The final rule retains the requirement for a conference to discuss:

- (1) the nature and basis of the involved claims and defenses,
- (2) the possibility of settlement of the case
- (3) ... [the possibility of] modification of the pleadings, and
- (4) plans for disclosures and discovery.

The final rule has been amended to clarify that the parties shall discuss the subjects outlined in Federal Rule 26(f) and any other subjects that the Board may, in an institution order, require to be discussed. Subjects the Board may require the parties to discuss could include, for example:

- (5) plans to supplement or modify the Board's standard protective order, or to substitute a different order,
- (6) whether the parties want to seek mediation, arbitration or to proceed under the Board's Accelerated Case Resolution option, ...
- (7) whether the parties want to enter into any stipulations of fact or stipulations as to the manner in which evidence may be presented at trial [,and]
- (8) any additional topics that could promote settlement or efficient adjudication of the Board proceeding.

[Number formatting added.] In previous TTAB cases, opposing counsel and I have found this checklist helpful in the past in organizing the discovery conference. (In fact, using it as a checklist was suggested by opposing counsel in the first TTAB case I had following adoption of the new rules.)

Among the additional topics I would like to include, as we discussed earlier this week, is to service by e-mail, without the need for hard copy by U.S. mail, which we are amenable to, if you reciprocate. If so, please cc: to my assistant, Annabel Renner (arenner@sksp.com) on all service by e-mail.

I look forward to speaking with you later this morning.

Regards,

Jonathan

Jonathan I. Feil
jfeil@sksp.com

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